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112

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,979	07/10/2001	Lutz Heuer	Bayer 8890.4-KGB	8954
27384	7590	02/09/2005	EXAMINER	
NORRIS, MC LAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			PRYOR, ALTON NATHANIEL	
		ART UNIT	PAPER NUMBER	
		1616		

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/901,979	HEUER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alton N. Pryor	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 22 December 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 9,11,12 and 15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 9,11,12,15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9,11,12,15 are rejected under 35 USC 112, 1<sup>st</sup> paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant broadly teaches synergistic combinations on page 9 lines 20-23. However, the specification fails to teach synergistic combinations comprising cyproconazole plus tebuconazole or propiconazole as claimed. Applicant provided a 132 declaration showing synergistic ratios of cyproconazole to tebuconazole and cyproconazole to propiconazole. However, the synergistic ratios have no support in the specification. In fact the only Example located in specification on page 17 is to activity of cyproconazole no mention of tebuconazole or propiconazole is present.

Claims 9,11,12,15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for synergistic compositions comprising cyproconazole plus tebuconazole or propiconazole. The specification does not enable any person skilled in the art to which it pertains, or with which it is most

nearly connected, to make and use the invention commensurate in scope with these claims. Experimentation must be conducted to determine the ratios of cyproconazole to tebuconazole and cyproconazole to propiconazole are synergistic. According to the reference (Kull et al, Applied Microbiology 9, 538-541, 1961) cited by applicant some combination ratios are antagonistic and others are additive. See pages 2-4 of the 132 declaration filed 7/22/02. Numerous experiments would need to be done in order to separate synergistic ratios from additive and antagonistic ratios of cyproconazole to tebuconazole or propiconazole.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9,11,12,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnavon in view of Valcke et al (US 5223524; 6/29/93). Barnavon teaches a composition comprising cyproconazole. Barnavon teaches the addition of a number of active ingredients to the composition. The actives include propiconazole, prochloraz, hexaconazole, flusilazole, etc. See abstract, column 1 lines 26-39, column 4 lines 1-31. Barnavon does not explicitly show in an Example a composition comprising cyproconazole plus propiconazole or tebuconazole. It would have been obvious to one having ordinary skill in the art to make a composition comprising cyproconazole plus propiconazole or tebuconazole. One would have been motivated to do this since

Barnavon suggests the composition comprising cyproconazole plus propiconazole. With respect to tebuconazole, Valcke teaches a composition comprising both tebuconazole and propiconazole. In Valcke's teaching it is suggested that tebuconazole and propiconazole are equivalent. See abstract, column 1 lines 21-62, and claim 1. Such a teaching would make it obvious to substitute the propiconazole taught by Barnavon with the tebuconazole taught by Valcke. One would have been motivated to do this since the prior art of Valcke's reveal that tebuconazole and propiconazole are equivalent. Applicant argues synergistic results for the combination of cyproconazole plus propiconazole or tebuconazole. Applicant broadly teaches synergistic combinations on page 9 lines 20-23. However, the specification fails to teach synergistic combinations comprising cyproconazole plus propiconazole or tebuconazole as claimed. Applicant provided a 132 declaration showing synergistic ratios of cyproconazole to tebuconazole and cyproconazole to propiconazole. However, the synergistic ratios have no support in the specification. In fact the only Example located in specification on page 17 is to activity of cyproconazole no mention of tebuconazole or propiconazole is present.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton Pryor  
Primary Examiner  
AU 1616